

The opinion is not binding precedent of the Board.

18
Paper 95

Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

Filed: March 2, 2006

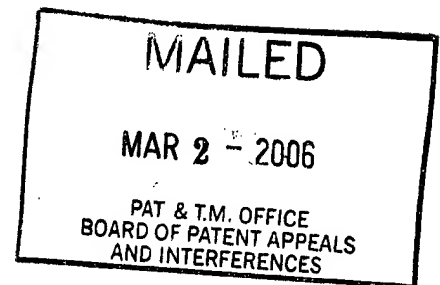
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ECKHARD BERNARDY
Junior party,
Application 09/035,936

v.

ROBERT A. POWELL
Senior party,
U.S. Patent 5,875,700



Patent Interference No. 104,671

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER and TORCZON,
Administrative Patent Judges

Judgment - Merits - Bd.R. 127

1 An earlier panel decision awarded judgment on priority against Bernardy. A judgment has
2 been entered in a civil action filed under 35 U.S.C. § 146 against Powell. The judgment held:

3 Plaintiff Bernardy is the true, first, original and sole inventor of the
4 invention claimed in claims 1 through 4 of U.S. Patent 5,875,700 . . . and
5 claims 42-59 of U.S. Patent Application 09/035,936 (hereinafter referred to
6 as the '936 application), and is therefore entitled to priority as the inventor,
7 pursuant to Sections 146, 102(f), and 102(g)(1) & (2) of the Patent Act, Title
8 35, United States Code.

A copy of the district court judgment is attached. In order to implement the judgment of the district court we vacate the prior panel judgment and enter judgment against Powell.

Order

It is

ORDERED that the judgment on priority entered June 30, 2003, (Paper 70) is vacated;

FURTHER ORDERED that judgment on priority as to the subject matter of Counts 1 and 2 (Paper 1, p. 5-6), is awarded against the senior party, ROBERT A. POWELL;

FURTHER ORDERED that senior party, ROBERT A. POWELL, is not entitled to a patent containing claims 1-4 (corresponding to Counts 1 and 2) of U.S. Patent 5,875,700;

FURTHER ORDERED that a copy of this judgment be made of record in the file of U.S. Patent 5,875,700 and 09/035,936; and

FURTHER ORDERED that if there is any settlement agreement which has not been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 41.205.

/Fred E. McKelvey/)
FRED E. McKELVEY)
Senior Administrative Patent Judge)

/Richard E. Schafer/) BOARD OF PATENT
RICHARD E. SCHAFFER) APPEALS AND
Administrative Patent Judge) INTERFERENCES

/Richard Torczon/
RICHARD TORCZON
Administrative Patent Judge

cc (Fed Ex):

Counsel for Bernardy

Kurt M. Rylander, Esq.
Rylander & Associates, P.C.
406 W. 12th St.
Vancouver, WA 98660

Counsel for Powell

Robert L. Harrington, Esq.
C/O Schwabe, Williamson and
Wyatt, P.C.
Pacwest Center, Suite 1600-1900
1211 S.W. Fifth Ave.
Portland, OR 97204-3713

William D. Robison, Esq.
Caron Colven Robison & Shafton,
P.S.
900 Washington St.
Suite 1000
Vancouver, Washington 98660

89.001

THE HONORABLE ROBERT J. BRYAN

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WASHINGTON
AT TACOMA

ECKHARD BERNARDY,

Plaintiff,

-v.-

No. C04-5604 RJB

ROBERT A. POWELL,

CONSENT JUDGMENT

Defendants.

Plaintiff, Eckhard Bernardy, filed this civil action against Defendant Robert A. Powell pursuant to 35 U.S.C. § 146, regarding claims 1 through 4 of U.S. Patent 5,875,700 (hereinafter referred to as the '700 patent) and claims 42-59 of U.S. Patent Application 09/035,936 (hereinafter referred to as the '936 application), following a final decision by the Board of Patent Appeals and Interferences granting priority to Defendant. The Complaint alleged that Plaintiff was the sole, true inventor of the subject matter described by claims 1-4 of U.S. patent '700 and claims 42-59 of U.S. patent application '936; that the '700 patent was invalid; and that Plaintiff was entitled to equitable relief of restitution, accounting, and disgorgement.

The parties stipulate to the entry of this Judgment in resolution of this suit and interference.

1
2
3 This Court now being fully advised in the premises does now Order, Adjudge and
4 Decree as follows:

5 1. This Court has jurisdiction over the parties under 28 U.S.C. §§1338,
6 1651, 2201, 2202, and as an action arising under laws of the United States, including 35
7 U.S.C. § 146 and 37 C.F.R. § 1.303-4, and venue over the parties under 28 U.S.C.
8 §1391.
9

10 2. Plaintiff Bernardy is the true, first, original and sole inventor of the
11 invention claimed in claims 1 through 4 of U.S. Patent 5,875,700 (hereinafter referred to
12 as the '700 patent) and claims 42-59 of U.S. Patent Application 09/035,936 (hereinafter
13 referred to as the '936 application), and is therefore entitled to priority as the inventor,
14 pursuant to Sections 146, 102(f), and 102(g)(1) & (2) of the Patent Act, Title 35, United
15 States Code.

16 3. That the '700 patent is invalid under 35 U.S.C. § 102(f) as derived from
17 the Bernardy invention described in the '936 application.

18 4. That Defendant Powell, his agents, employees, successors, assigns and
19 all those in privity with said Defendant or acting on his behalf or under his control are
20 permanently enjoined from directly or indirectly making, , selling, or causing to be sold
21 apparatus or devices embodying the invention claimed in claims 1 through 4 of the '700
22 patent or claims 42-59 of the '936 application.
23

24 5. That Defendant Powell will execute an assignment of all right and title to
25 Canadian Patent Application CA 2209054 titled "Monocoque Pruning, Mulching and
26 Cutting Blade," and any patents issuing therefrom, as well as executing any papers
27
28
29

1
2
3 needed to be filed with the Canadian Intellectual Property Office to make such
4 assignment effective.

5 6. This Court shall retain jurisdiction and venue over the parties with regard
6 to the Settlement Agreement which the parties have entered.

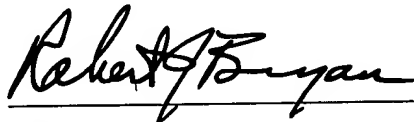
7 7. All other parties and claims are dismissed with prejudice.

8 8. Each party shall bear its own costs and attorney's fees.

9 9. An original copy of this judgment and order will be filed with the Director of
10 the Patent and Trademark Office.
11

12 SO ORDERED AND ADJUDGED:

13 DATED this 7th day of November, 2005.
14

15 
16

17 ROBERT J. BRYAN
18 United States District Judge
19
20
21
22
23
24
25
26
27
28
29